

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

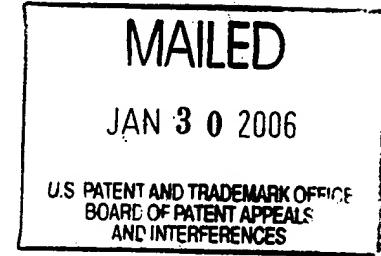
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte John A. Wheatley and Walter J. Schrenk

Appeal No. 2005-2515
Application No. 09/911,532

HEARD: December 14, 2005



Before KRASS, BARRETT, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 30-35, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a polymeric interference film. A copy of representative claim 30 under appeal is set forth below.

30. A multilayer interference film comprising alternating layers of at least a first and second diverse polymeric material, the alternating layers having a reactive index mismatch in at least a first plane perpendicular to the film and having layer thicknesses suitable to reflect light over a range of wavelengths, wherein one of the first and second diverse polymeric materials comprises a polymer selected from the group consisting of polyethylene naphthalate and a copolymer of ethylene naphthalate.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rogers	3,610,729	Oct. 5, 1971
Utsumi (Utsumi '953)	4,756,953	Jul. 12, 1988
Utsumi (Utsumi '772)	4,799,772	Jan. 24, 1989

Claims 30-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rogers in view of Utsumi '953 or Utsumi '772.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed July 13, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed April 27, 2004) and for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)]. We note that appellants have elected to group ALL claims as standing or falling together at page 3 of the Brief. Therefore, we select independent claim 30 and address appellants' arguments thereto.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d

1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Products Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would

lead that individual to combine the relevant teachings of the references.” **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 30. We find that independent claim 30 sets forth an article of manufacture having alternating layers of first and second polymeric material.

Appellants argue that Utsumi teaches the use of polyethylene napthalate (PEN) as having advantages over polyethylene terephthalate (PET) as a uniaxially stretched PET film for use in a liquid crystal display or for polarizing plates. (Brief at page 4.) Appellants argue that Rogers teaches the use of PET in a multilayered light polarizer

using two different materials in coextrusion. (Brief at pages 5-6.) Appellants argue that the Utsumi references teach their application as monolithic, single layer films which is very different from the birefringent films of Rogers. (Brief at pages 4-5.) Appellants argue that due to the very different applications and the corresponding different features and requirements of the Utsumi references relative to the Rogers reference, the examiner must have relied upon impermissible hindsight to use PEN in a multilayer film. Additionally, the coextrusion process raises considerations with regards to the coextruded materials that are not of concern when making a monolithic film. Appellants argue that Rogers acknowledges that PET lends itself to the coextrusion process and that this means that other materials do not lend themselves to coextrusion. Appellants argue that since Utsumi does not provide guidance about the use of PEN to a coextrusion process that at most this is an invitation to try which falls short of the standard required for a *prima facie* case of obviousness. (Brief at page 5.) We disagree with appellants, find that the claim is directed to an article of manufacture and does not expressly require a specific process, and we find no express limitations which would require a coextrusion process. Therefore, this argument is not commensurate in scope with the instant claim language, and we do not find the argument persuasive.

The examiner maintains that Utsumi '772 and Utsumi '953 teach and suggest that PEN is has advantages over PET and that skilled artisans would have been

motivated to use PEN in the multilayer film of Rogers to replace the PET to improve heat resistance, heat shrinkage ratio, mechanical properties and the degree of polarization. (Answer at page 3 and 5.) (See Utsumi '953 at columns 1 and 7-11; and Utsumi '772 at columns 2, 3, 4, and 8.) From the express suggestions in both Utsumi references, we agree with the examiner that it would have been obvious to one of ordinary skill in the art to have used PEN in place of PET in Rogers to make the multilayer interference film. We find that appellants' arguments to the process of making the film go beyond the express limitations recited in the article of manufacture, and we find no express support for these arguments in the language of independent claim 30. Therefore, we do not find the argument persuasive, and we will sustain the rejection of independent claim 30 and its dependent claims 31-35.

CONCLUSION

To summarize, the decision of the examiner to reject claims 30-35 under 35 U.S.C. § 103(a) is AFFIRMED.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED



ERROL A. KRASS
Administrative Patent Judge

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BOARD OF PATENT
APPEALS
AND
INTERFERENCES



LEE E. BARRETT
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge

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